

REMARKS

Claims 1, 3-9, 12, 15, 16, 19, 21, and 22 remain in the application with claim 1 in independent form. Claims 2, 10, 11, 13, 14, 17, 18, and 20 were previously cancelled. Claims 6-9 were previously withdrawn from consideration subject to possible rejoinder should independent claim 1 be allowed. No new subject matter has been added in the instant Response.

Claims 1, 3-5, 12, 15, 16, and 19 stand rejected under 35 U.S.C. §103(a) over alleged admitted prior art (APA). The Applicants respectfully submit that the instant rejections are improper, as set forth further detail below, on the basis that the Applicants have made no admission that the substance of paragraph [0008] of the instant application is in the prior art such that the Examiner's rejections that rely on Applicants' alleged admitted prior art are in error.

The Applicants respectfully submit that, to rely upon APA for purposes of establishing rejections, Examiners must adhere to proper methodologies for doing so as set forth in the MPEP. It is recognized that under some circumstances, statements made in the Applicants' specification may be deemed admissions as to prior art. Applicants' statements that amount to admissions of prior art are set forth in MPEP 2129. Importantly, MPEP 2129 is very clear that “[a] statement by an applicant >in the specification or made< during prosecution identifying the work of another as “prior art” is an admission ***>which can be relied upon for both anticipation and obviousness determinations.” (Emphasis original). Clearly, when the Applicants' statements **do not** identify work of another, other conditions apply. In particular, as also set forth in MPEP 2129, even if labeled as “prior art,” the work

of the same inventive entity may not be considered prior art against the claims unless it falls under one of the statutory categories.

In the instant case, the Applicants respectfully submit that it is clear that paragraph [0008] of the instant application, which was relied upon by the Examiner to establish the instant rejections based upon APA, **does not represent work of another**. In fact, the Applicants respectfully submit that there is ample evidence that the content of paragraph [0008] represents the Applicants' own work and merely reflects findings that were made by the Applicants and that are set forth in Comparative Examples 1 and 2. Referring to paragraph [0007] in the instant application, the Applicants indicated that “[b]ecause silicone based adhesive agents possess superior handling characteristics . . . , it is expected that they can be used for securing IC chips to leadframes in the die bonding step.” (Emphasis added). Indication of an **expectation**, as the Applicants did in paragraph [0007], is clear evidence of the fact that the substance of paragraph [0007] is clearly the product of Applicants' thought process and is **not** an indication that others have used silicone based adhesive agents in the past for securing IC chips to leadframes in the die bonding step. As such, because the Applicants **have not even** indicated that others have used silicone based adhesive agents for securing IC chips to leadframes in the die bonding step, the Examiner clearly cannot interpret paragraph [0008] as an indication that others have used silicone based adhesive agents for securing IC chips to leadframes in the die bonding step with the silicone based adhesive agent formed on a surface of base film that has a thin acrylic based pressure sensitive adhesive agent layer formed on its surface.

As further evidence of the fact that the Applicants' description in paragraph [0008] is not identifying the work of another, the Applicants note there is no indication whatsoever that the content of paragraph [0008] is prior art. Further still, the content of paragraph [0008] is directly correlated to work that was actually performed by the Applicants and described in detail in Comparative Examples 1 and 2. Importantly, the Comparative Examples 1 and 2 are not indicated as prior art examples, and it is clear that paragraph [0008] merely represents findings made by the Applicants during the course of their own experimentation.

In view of the foregoing, the Applicants respectfully submit that the Examiner has erred by relying upon the specification of the instant application in issuing the instant rejections of the claims, especially because the Applicants have not explicitly or implicitly represented that the contents of paragraph [0008] represent the work of another and because the content of paragraph [0008] is clearly derived from experimentation (from Comparative Examples 1 and 2) that the Applicants performed themselves. As such, the Applicants respectfully submit that the Examiner must find a basis other than in the instant application to properly establish the instant rejections over the content set forth in paragraph [0008] of the instant application.

The Applicants respectfully assert that, in the absence of prior art that discloses or teaches every element of independent claim 1, the Applicants are entitled to allowance of independent claim 1 and the claims that depend therefrom. As such, the Applicants respectfully submit that independent claim 1 is both novel and non-obvious and, thus, is in condition for allowance. The remaining claims each depend upon the novel and non-obvious

features of independent claim 1 such that the Applicants respectfully submit that these claims are also in condition for allowance. Finally, the Applicants respectfully request rejoinder of withdrawn claims 6-9 upon allowance of independent claim 1, from which claims 6-9 depend.

This Response is timely filed such that it is believed that no fees are presently due. However, the Commissioner is authorized to charge our deposit account no. 08-2789 for any additional fees or credit the account for any overpayment.

Respectfully submitted,

HOWARD & HOWARD ATTORNEYS PLLC

Date: May 26, 2009

/Christopher S. Andrzejak/

Christopher S. Andrzejak, Reg. No. 57,212
450 West Fourth Street
Royal Oak, MI 48067
(248) 723-0438